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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,698	02/08/2002	Dirk Muessig	7163-38	2519

21324 7590 12/02/2003
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EXAMINER

MULCAHY, JOHN M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 12/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/072,698

Applicant(s)

MUESSIG ET AL.

Examiner

John M. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Respons to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amundson et al. (6,178,346) in view of Brucker et al. (5,643,197) as set forth in section 2 of the previous Office action (Paper No. 9).

4. Claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelzer et al. (6,309,345) in view of Brucker et al. (5,643,197) as set forth in section 3 of the previous Office action (Paper No. 9).

5. Claims 2, 3, 7, 8, 15, 16, 19, 20, 23, 24, 27, 28, 31, 32, 35, 36, 39, 40, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelzer et al. (6,309,345) in view of Brucker et al. (5,643,197) as applied to claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 above, further in view of Roth et al. (6,079,414), which incorporates Fantone et al. (4,786,155) by reference (col. 18, lines 24-26), as set forth in section 4 of the previous Office action (Paper No. 9).

6. Claims 4, 5, 9, 17, 21, 25, 29, 33, 37, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stelzer et al. (6,309,345) in view of Brucker et al. (5,643,197) and Roth et al. (6,079,414), which incorporates Fantone et al. (4,786,155) by reference (col. 18, lines 24-26), as applied to claims 2, 3, 7, 8, 15, 16, 19, 20, 23, 24, 27, 28, 31, 32, 35, 36, 39, 40, 43 and 44 above, further in view of Adair et al. (4,782,819) as set forth in section 5 of the previous Office action (Paper No. 9).

Response to Arguments

7. Applicant's arguments filed August 6, 2003 have been fully considered but they are not persuasive.

8. Applicant argues that Bruckner '197 is non-enabling for the teaching relied upon in the rejection since "There is simply no embodiment taught in Bruckner '197 of a catheter tip electrode, particularly one that could serve as an ablation electrode, through which an optical endoscope could view the tissue in the vicinity of the tip."

However, U.S. Patents are presumed to be enabled. The burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). Applicant's bare argument is insufficient.

In any case, Bruckner '197 teaches (col. 7, lines 40-60) that the device 42 (such as an endoscope, see col. 9, line 66, through col. 10, line 6) may be passed through the

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central lumen, 74 which is in communication with a central aperture 54 within the electrode (see Figs. 7, 9), an arrangement analogous to Applicant's Fig. 2.

Final Rejection

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

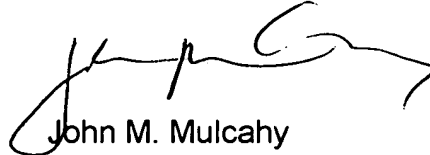
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John M. Mulcahy
Primary Examiner
Art Unit 3739

John Mulcahy
December 1, 2003